

REMARKS/ARGUMENTS

Applicant has amended claims 1, 2, 13, 14, 19, 28, 29, and 30 of the claims in issue considered by the Examiner in the Final Office Action dated March 2, 2010. Upon entry of the response and of the amendments, claims 1-25 and 27-30 are pending for reconsideration by the Examiner.

Upon further reflection, Applicant has amended claim 1 to delete the term "conveying of signals" and be more in accordance with the specification. The support for the amendments is given in Paragraphs 0001 – 0003, and 0049.

Applicant has amended claims 29 and 30 to better conform to claim 1. The support for the amendments is given in Paragraphs 0001 – 0003, 0049 and 0058. Now claim 29 contents all limitations of claim 1 concerning the moulded structure and manner of mouse operation.

The Examiner will appreciate that in claim 29, Applicant essentially claims a moulded structure mounted to the button of the conventional mouse.

Grammatical corrections involving the use of commas in the claims are also made. Applicant has amended claims 2 and 13 to better define the term "pocket,"

The Examiner will appreciate that the position of the user's fingers and hand resting on the working surface and forming the **pocket, i.e. hollow concave shape** between the user's hand and working surface is **explicitly**

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describes in the Applicant's claims 1 and 2, and the specification at Paragraphs 0030, 0032, and 0037.

The Examiner has repeatedly rejected claims 1-13, 24 and 27 -30 under 35 U.S.C. § 103(a) as being obvious by Adler (US Patent 6,256,015 B1). Applicant respectfully traverses the rejections.

Applicant has noted the Examiner's argument that the rejections are made under 35 U.S.C. § 103, and **not** under § 102.

Applicant continues to assert that claims 1, 2, and 29 were patentable over the cited Adler reference for the reason that the Examiner has not properly applied the legal requirements for the rejections under 35 U.S.C. § 103.

The Examiner will appreciate that the MPEP §2142 states as follows:

"the Examiner bears the initial burden of factually supporting any prima facie conclusion of obviousness. If the Examiner does not produce a prima facie case, the Applicant is under no obligation to submit evidence of non-obviousness."

and further in the MPEP §2143:

"To establish a prima facie case of obviousness three basic criteria must be met. First, there must some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or combine the reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations."

In the Office Action dated December 23, 2009 the Examiner states:

"To claim that to depress the button at a tangential angle to the surface is obvious. Examiner wants the language about the actual angled structure and more details about the tangential angels in the claims and feels that would overcome the current rejections."

In the response to Office Action (from December 23, 2009) dated January 18 Applicant amended the claims 1, 2, 29 and 30 to better define the language of the limitation as follows:

"...said ... button being actuated ...by a force applied tangential to said angled upper surface of said ... button by said ... fingertip when stroking by said ... fingertip said angled upper surface of said ... button in a combined down-forward motion against said moulded contact surface."

Furthermore, Applicant submitted the illustrations of Adler's Fig. 4 to demonstrate that Adler does **not** teach any structure mounted to the upper surface of the button which could allow the user to actuate the button by the tangential movement of the fingertip, when stroking the upper surface thereof.

Nevertheless, in the Office Action dated March 2, 2010 the Examiner has rejected the claims under 35 U.S.C. §103(a) and made the Office Action as **Final** with the following statement:

"Examiner notes several pages of Applicant's arguments which go to Adler's structure, but the limitations which would differentiate the two structures are not claimed."

The Examiner will appreciate the following limitations of Adler's disclosure and Applicant's claims which differentiate the both structures structurally and in function.

Applicant claims the **mould formed or attached on the button** which **allows button actuating** by a force applied tangential to the angled upper surface of the button by the fingertip, when stroking by the fingertip the angled upper surface of the button in a combined down-forward motion against the moulded contact surface.

In contrast, Adler teaches the **cover being attached to the mouse casing**, which has the aperture to provide button actuating through the aperture by the fingertip movement directed perpendicularly to the surface of the button.

The Examiner will appreciate that Adler's pad 49 being attached to the button does **not** provide sufficient contact surface with the fingertip to actuate the button by the fingertip movement directed **tangentially** to the upper surface of the button, when **stroking by the fingertip** the surface of the pad 49; and

that a **force applied to the edge of Adler's cover** being supported by the mouse casing, **(it does not matter in which direction)**, will **not actuate the button**.

Furthermore, in the Advisory Action from April 15, 2010 the Examiner states:

"As for Applicant's arguments on the tangential movement, Adler does indeed teach of this. The dictionary definition of tangential means touching a

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surface at a point and Adler does indeed teach of touching the mouse as well as operating the mouse at a tangential angle to the surface.”

Throughout the prosecution of the case the Examiner has rejected the claims by simply declaring all of the elements of Applicant's disclosure to be well known in the art.

In a view of the following:

“The courts have stated the Examiner cannot discharge himself from the burden of showing all the claimed elements by simply declaring all of the elements of an invention, along with the manner of combining these elements, to be well known in the art.” See Ex parte Stern, 13 USPQ2d 1379, 1381 (Bd. Pat. App. & Inter. 1989).

Applicant would appreciate if the Examiner could clearly show or identify the Adler's structure being attached to the button which could allow button actuating by a **force applied tangential** to the upper surface of the button by the fingertip, **when stroking by the fingertip** the upper surface of the button against such structure.

It is a paradox that the Examiner has the mouse in the hand and **not** trying to actuate the button of the conventional mouse by the tangential movement, when stroking by the fingertip the upper surface of the button, in order to prove the statement.

The Examiner will appreciate that MPEP §2142 states the following:

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"The burden is on the Examiner to demonstrate that the prior art evidence is sufficient suggestion of the desirability of doing what the inventor has done."

Sir:

It is respectfully submitted, could you try, please, to **actuate** the button of the conventional mouse **by the tangential movement, when stroking by the fingertip the upper surface of the button?**

The Examiner will appreciate the given dictionary definition for the term "stroke" as *"to **stroke** pass the fingertip **gently** over the surface"* and the following:

"Evidence showing there was no reasonable expectation of success may provide a conclusion of nonobviousness. See MPEP §2143.02 citing In re Reinhart, 189 USPQ 143 (CCPA 1976)."

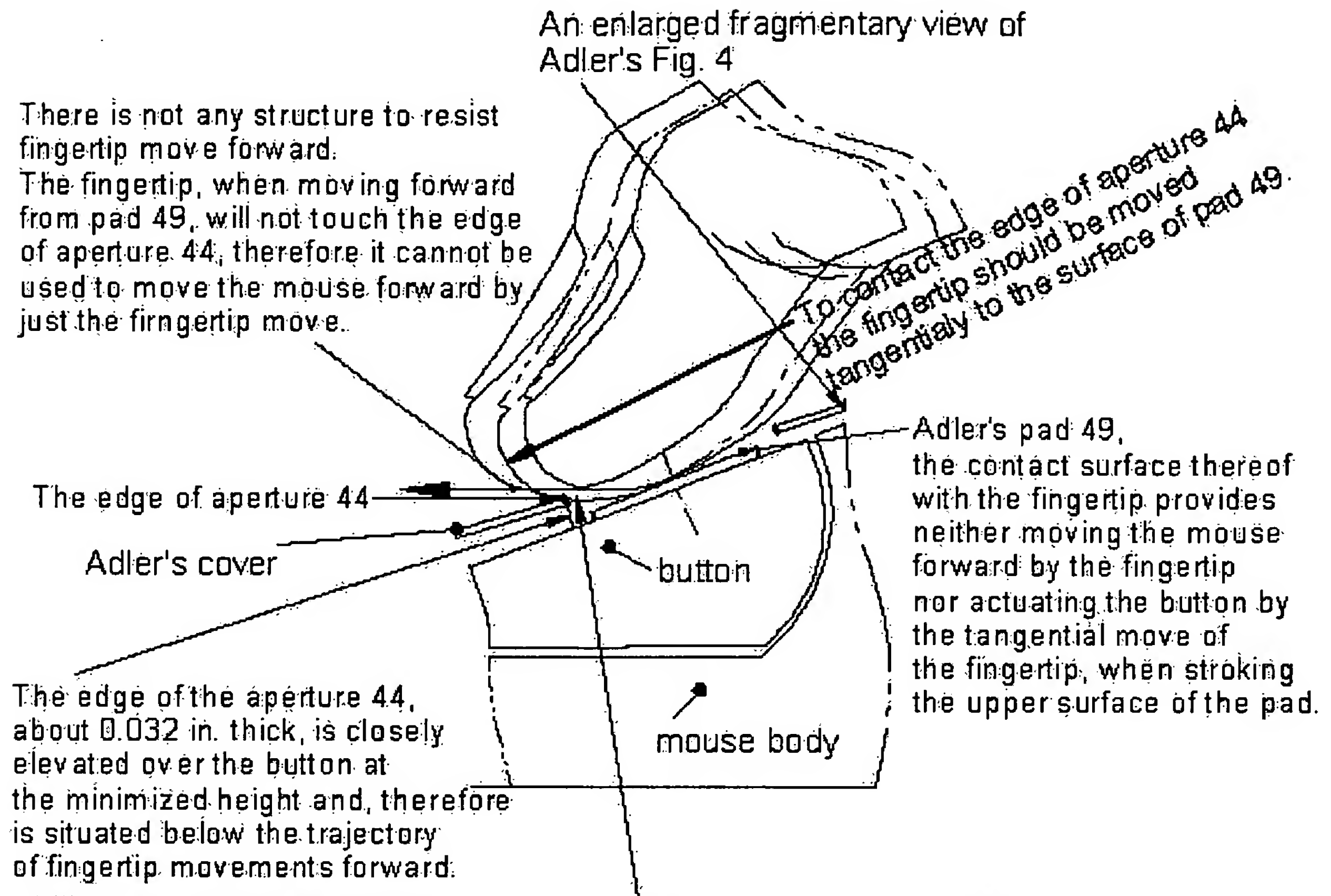
Taking into account the all above mentioned and, hopefully, after taking some attempts to actuate the button of the conventional mouse in the way suggested by Applicant the Examiner will appreciate that none of the criteria to establish a *prima facie* case of obviousness is met by the Examiner in the rejections and cited Adler's reference; therefore, the Examiner's rejections of claims 1, 2, and 29, it is respectfully submitted, are improper.

Further, Applicant continues to assert that claims 1, 2, and 29 were patentable over the cited Adler reference for the reason that the Adler reference does **not** disclose, teach, suggest or **motivate** any **structure** which could enable the user to actuate the button by the fingertip move directed tangentially to the

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surface of the button, when **stroking by the fingertip** the angled **upper surface of the button** in the combined down-forward motion, **or move** securely the mouse by just the **fingertip movement forward**.

To support Applicant's assertion, Applicant repeats below an annotated fragmentary illustration of Adler's Drawings, Figs. 4, and further annotated with an inserted contour of the finger.



The fingertip should not contact the edge of aperture 44, because the sufficient clearance around the fingertip and the edge should be provided to enable the user to actuate the button by depressing it by the finger move directed perpendicularly to the surface of the button. To contact the edge of aperture 44 with the fingertip one of skill should move their fingertip first tangential to, like stroking, the surface of pad 49.

Once contacted the edge with the fingertip one of skill can neither actuate the button, because the edge being placed under the fingertip will hinder depressing the button, nor move the mouse forward by the fingertip, because the edge is still below the trajectory of fingertip movements forward.

By considering the above submitted illustration the Examiner will appreciate the following limitations of Adler's disclosure and Applicant's claims.

First, Adler teaches the **cover** being **attached to** the mouse **casing**, which has the aperture to provide button actuating through the aperture.

This seems self-evident, if not inherent, that a sufficient clearance around the edge of the aperture and fingertip **must** be provided to allow directly actuating the button by the fingertip movement through the aperture.

Adler describes “*means disposed **between the upper surface of the button and the lower surface of the cover for indirectly actuating the buttons** ...*” (Paragraph 7, claim 2, lines 41-43, emphases added) The means, like pad 166 being attached to the button, protrude through the cover **over the edge** of the aperture.

Adler does **not** teach or motivate **direct contact** for the fingertip with the edge of the aperture, because the **edge will hinder fingertip movement** through the aperture **by button actuating**.

This means that the **empty space** between the **upper surface** of the **button** and the **lower surface** of Adler’s cover, and between the **fingertip** and the **edge** of the aperture, **obviously cannot** be identified as a **contact** surface for the fingertip with Adler’s cover, correspondingly, with the edge of the aperture, when placed on the pad 49, which is attached to the upper surface of the button.

Contrary to Adler, Applicant claims the **mould** being **formed or attached on the button**. The mould **tapers** upwardly from the upper surface of the button at the **height**, which provides the **moulded contact surface** for **direct contact** with the **fingertip**, when placed on the mould.

The given dictionary definition for the term “moulded surface” as “to **mould** something round a fingertip - to **fit tightly round** the shape of a fingertip” presumes direct contact for the fingertip with the moulded surface of the button.

Thus, the Examiner’s assertion that the edge of Adler’s aperture which is supported by the mouse casing and must **not** be in touch with the fingertip to allow button actuating through the aperture, and Applicant’s mould which is formed or attached to the button and **fit tightly round** the shape of a fingertip, thereby providing the moulded contact surface with the fingertip, are **substantially the same structures**, it is respectfully submitted, is incorrect.

These **obvious structural differences** between Adler’s cover, and Applicant’s mould or the moulded contact surface **distinguish** both the devices **in function**.

Applicant’s **mould** being **formed or attached** on the upper surface of the **button** provides the **moulded contact surface** for **direct contact** with the **fingertip**, which **allows** actuating the button by the fingertip movement directed **tangentially** to the angled upper surface of the button, when stroking by the fingertip the upper surface thereof in the combined down-forward motion against the moulded contact surface.

In contrast, Adler’s pad 49 being attached to the button does **not** provide sufficient contact surface with the fingertip to actuate the button by the fingertip move directed **tangentially** to the upper surface of the button, when **stroking by the fingertip** the surface of the pad 49. And as mentioned above, the Examiner

will appreciate that a **force applied to** the edge of Adler's **cover** being supported by the mouse casing, (**it does not matter in which direction**), will **not actuate** the **button**.

Secondly, the "thicknesses" asserted by the Examiner in the Response to Arguments, dated March 2, 2010, as being **not** claimed in the Applicant's disclosure, **is explicitly claimed** by Applicant as the **height**, at which the **mould tapers** upwardly from the upper surface of the button, thereby **providing** the **moulded contact surface** for direct contact with the **fingertip**, which allows the user to **move securely the mouse** in the **forward** direction by just the **fingertip movement forward**.

In contrast, Adler teaches the **edge** of the aperture being **closely** elevated over the **angled** upper surface of the button and, as **seen** in the above submitted **illustration**, the edge is **obviously** situated **below** the trajectory of the fingertip movements forward.

Thus, as it can be seen in the above submitted illustration Adler does **not** teach **any structure to resist fingertip movement directed forward**.

Applicant would appreciate if the Examiner could clearly show or indicate the Adler's structure which could resist fingertip movement forward and allow moving the mouse forward by just the fingertip movement.

To move the mouse forward by just the fingertip move, when pushing against such structure, the Examiner suggests using the edge of Adler's

aperture; this is **closely** elevated above the button at the **minimized** height and is **not** in direct **contact** with the **fingertip**.

To contact the edge in order to move the mouse forward, as suggested by the Examiner, one of skill must **first move** their fingertip **tangentially to**, like stroking, the upper surface of the pad 49 in the combined down-forward motion.

This **move** will **affect nothing**; neither mouse button actuating nor mouse movement forward. In this context, the Examiner will appreciate that:

“Evidence showing there was no reasonable expectation of success may provide a conclusion of nonobviousness.” See MPEP §2143.02 citing In re Reinhart, 189 USPQ 143 (CCPA 1976).”

By the same fingertip move, when placed on Applicant’s mould, the button would be already actuated without actuating mouse movement.

Further, once contacted the edge with the fingertip one of skill can **neither actuate the button**, because the edge being placed under the fingertip will hinder depressing the button, **nor move the mouse forward by the fingertip**, because the edge is still bellow the trajectory of fingertip movements forward, as it can be seen in the above submitted illustration.

The Examiner suggests claiming a value or a range of the mould height in order to differentiate from Adler, and thereby to overcome the current rejections.

The Examiner will appreciate that the range at which Adler’s edge is **closely** elevated over the button can be appreciated by one of the ordinary skill as being between **zero and minimized**; and as it is claimed by Adler, there is

the empty space between the **upper surface** of the **button** and the **lower surface** of Adler's cover.

Contrary to Adler, the Applicant's mould being tapered even at the minimized height forms the moulded contact surface which could provide at least button actuating, when pushing against the surface.

The **range of the mould height is claimed** by Applicant and can be appreciated as being between **minimized** and the **height** which provides the moulded contact surface, which allows the user to **move securely the mouse** in the **forward** direction by just the fingertip movement forward.

Taking into account the above discussed structural differences between the claims and the Adler disclosure, the Examiner appreciates that Adler cannot anticipate Applicant's claims.

Furthermore, Adler does **not** teach, suggest, or motivate **any structure**, which could **enable** the user to **move** securely the mouse by just the **fingertip movement forward** or **actuate** the button by the **fingertip movement directed tangentially**, when stroking by the fingertip the surface of the button; therefore, the Examiner's rejections of claims 1, 2, and 29, it is respectfully submitted, are improper.

Claims 3-25 and 27-30, which depend directly or indirectly in claims 1 and 2, are patentable for the reasons advanced for claims 1 and 2.

Applicant submits that the amendments as presently submitted very clearly cannot be remotely disclosed, taught, or suggested in the cited Adler

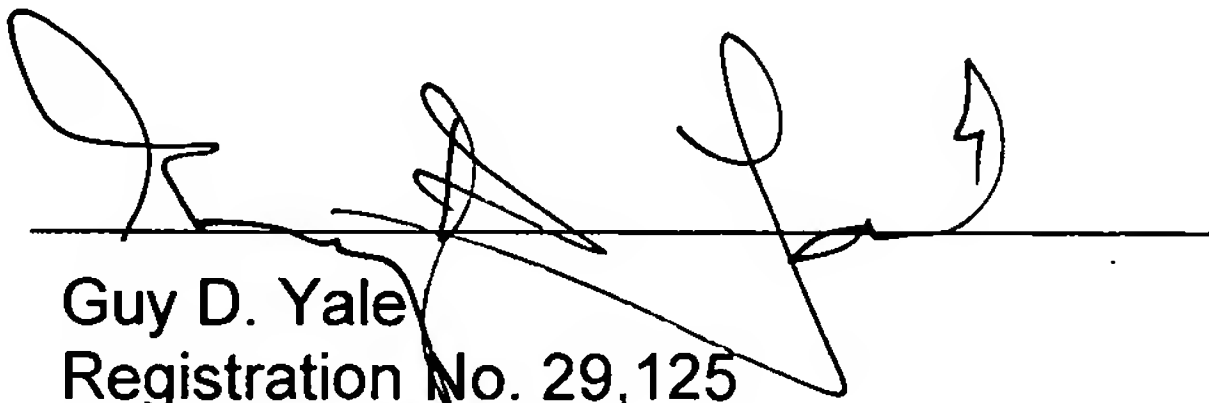
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reference (or in combination with any other reference cited or identified by the Examiner).

For the reasons discussed herein, Applicant respectfully contends that the Examiner's rejections are improper and respectfully request that the present claims be passed to issuance.

Respectfully Submitted,

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